

REMARKS

In an Office Action mailed on November 12, 2003, claims 13, 14, 20, 21, 35 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Baird in view of King; claims 27, 28, 31 and 32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ownby; objections were made to claims 34, 36, 42, 48 and 50; claims 11, 12, 15, 16 and 22 were objected to as being dependent upon rejected base claims but allowable if rewritten in independent form; and claims 1, 2, 6-8, 17-19, 23-26 and 37-54 were allowed. Claims 11, 12, 15, 16 and 22 have been rewritten in independent form as claims 55-59, respectively. Because these claims were indicated as being allowable if rewritten in independent form, allowance of claims 55-59 is requested. For purposes of expediting prosecution, claims 27, 28, 31 and 32 have been cancelled, thereby rendering the § 102 rejections of these claims moot. The claim objections and § 103 rejections are discussed below.

Claim Objections:

Claims 36, 42, 48 and 50 have been amended to overcome the objections due to the lack of a proper antecedent basis for the phrase "the feature." However, claim 34, also rejected on the same basis, does have a proper antecedent basis for the phrase "the feature." More specifically, claim 33, from which 34 depends, recites, "sensing a change in a strength of the flux field to indicate detection of a feature of the pipe." Therefore, because claim 34 does have antecedent basis for the phrase "the feature," withdrawal of the objection to claim 34 is requested.

§ 103 Rejections:

Regarding the remaining § 103 rejections, the Examiner contends that, "there is no requirement that a motivation to make the modification are expressly articulated." Final Office Action, 3. Thus, it appears the Examiner is relying on the alleged general level of skill in the art for the motivation or suggestion to combine references. However, for a *prima facie* case of obviousness, the Examiner must support the alleged suggestion or motivation with a specific cite to some portion of a cited reference, as "obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966); *Ex parte Gambogi*, 62

USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143. The reliance on the alleged general level of skill in the art is similar to the fact pattern in *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

More specifically, in *In re Fine*, the Federal Circuit held that the Examiner had failed to establish a *prima facie* case of obviousness because of the Examiner's bald assertion that a substitution "would have been within the skill of the art," without offering any support for or explanation of this conclusion. *In re Fine*, 5 USPQ2d at 1599. The Federal Circuit agreed with the appellant that a *prima facie* case of obviousness had not been established and stated, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.*, 1600. *See also, W.L. Gore & Associates, Inc v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983) (stating, "to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against his teacher"); *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999) (stating, "rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment").

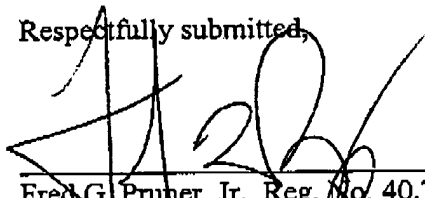
Therefore, for at least the reason that the Examiner fails to show where the prior art contains the alleged suggestion or motivation for any of the §103 rejections, a *prima facie* case of obviousness has not been established for any of the remaining rejected claims.

Thus, withdrawal of the remaining § 103 rejections and a favorable action in the form of a Notice of Allowance are requested.

CONCLUSION

In view of the foregoing, withdrawal of the § 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (22.1414).

Respectfully submitted,



Date: January 8, 2004

Fred G. Pruner, Jr., Reg. No. 40,779
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, Texas 77024
(713) 468-8880 [Phone]
(713) 468-8883 [Fax]